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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,569	09/26/2005	Thomas Sonnenrein	10191/3587	5517
26646	7590	06/26/2007	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			TO, TUAN C	
ART UNIT		PAPER NUMBER		
3663				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/516,569	SONNENREIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Tuan C. To	3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 27 March 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 26-30, 32 and 33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 17-25 and 31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 December 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 17-24 are rejected under 35 U.S.C. 102 (a) as being anticipated by Rigo et al. (US 20020049535A1).

Regarding claims 17-19, Rigo et al. discloses a system/method for performing a telematics service on a vehicle (paragraph 0022, lines 1-8) comprising: subdividing the telematics service into partial telematics functionalities that are critical with respect to time (figure 2, paragraphs 0043 and 0047, telematics functionalities that are critical with respect to time executed in a motor vehicle via an on-board telematics unit 32), and partial telematics functionalities that are not critical with respect to time (figures 1-3, a plurality of service providers are wirelessly connected with the vehicle telematics unit 32), establishing a communication connection between a server and the vehicle telematics unit located in the vicinity of the vehicle (figure 1, the communication is established between a server and the vehicle telematics unit via the wireless service (16), executing in the server the partial telematics functionalities that are not critical with

respect to time (figures 1-3, a plurality of service providers are wirelessly connected with the vehicle telematics unit 32), and executing in the telematics unit (32) the partial telematics functionalities that are critical with respect to time (figure 2, paragraphs 0043 and 0047, telematics functionalities that are critical with respect to time executed in a motor vehicle via an on-board telematics unit 32).

As to claim 20, in Rigo et al. the partial telematics functionalities that are critical with respect to time are executed in the vehicle telematics unit (32), and the partial telematics functionalities that are not critical with respect to time are implemented by the server at a service provider (figure 1, paragraph 0040).

As to claim 21, Rigo et al. further teaches that the partial telematics functionalities that are critical with respect to time comprise the communication with a control unit located in the vehicle (see figure 3, a communication is established with the vehicle telematics unit 32 via the vehicle control unit 42).

As to claims 22-24, Rigo et al. teaches a remote diagnosis service provider (figure 1, auto repair service (30) is a remote diagnosis service provider that provides a remote diagnosis). Because the vehicle user can access the auto repair service (30) via the Internet (20), the remote diagnosis is inherently implemented through a diagnosis protocol.

Rigo et al. inherently teaches: "the telematics service includes a remote diagnosis of the vehicle, the remote diagnosis being implemented through a diagnosis protocol, and wherein the diagnosis protocol is implemented in the server"

Claim 31 is rejected under 35 U.S.C. 102 (a) as being anticipated by Saito et al. (US 20020044049A1).

Saito et al. directs to a vehicle system/method for performing a remote diagnosis of a vehicle, comprising: "activating the remote diagnosis by establishing a communication connection between a server and a data terminal located in the vicinity of the vehicle". In Saito et al., a communication connection is established, between the mobile terminal (111) and the server (100) via the network (103) (Saito et al., figure 1). A vehicle diagnosis is remotely performed by transmitting the vehicle data collected from the vehicle (104) (See Saito et al., figure 1) to server computer (100). The mobile telephone set (111) is activated to transmit the vehicle data to the server (100). The server (100) transmits results of evaluation to mobile terminal (111) after evaluating the answers in the server (Saito et al, figure 11; page 1, paragraph 0009, abnormal analysis process is done at the server of a service company after the abnormal data received from mobile terminal via the Internet 103).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigo et al. (US 20020049535A1) and in view of Robinson et al. (US 6647323B1).

Rigo et al. teaches a remote diagnosis service provider, however, Rigo et al. fails to include that the diagnosis protocol includes KWP2000.

Robinson et al. teaches a vehicle system/method in which the diagnosis protocol includes KWP2000 (column 2, lines 24-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system/method as taught by Rigo et al. to include the diagnosis protocol of Robinson et al so that the vehicle controller software is capable of interfacing with a communication network that comprises the KWP2000, and therefore a remote development, diagnostic, and other software tool can communicate with the

communication network to access vehicle process variables and data in the memory of the vehicle controller.

***Response to Arguments***

Applicant's arguments with respect to claims 17-25 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

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A handwritten signature in black ink, appearing to read "Tuan C To", is written over a horizontal line.

Tuan C To

June 5, 2007